

**REMARKS**

Claims 1, 3, 5, 7, 9, 11, 13 and 16-21 are pending in this application. By this Amendment, claims 1, 3, 5, 7, 9, 11, 13, 16 and 17 are amended and claims 18-21 are added. No new matter is added by these amendments. Also, claims 2, 4, 6, 8, 10, 12, 14 and 15 are canceled without prejudice or disclaimer. Reconsideration based on the above amendments and following remarks is respectfully requested.

**I. Personal Interview**

Applicants greatly appreciate the courtesies extended to Applicants' representative by Examiner Getaneh and Supervisory Patent Examiner Zimmerman in the December 17, 2008 personal interview. Applicants' separate record of the substance of the interview is incorporated below.

**II. The Claims Define Allowable Subject Matter**

The Office Action rejects claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over Teraura (U.S. Patent Application Publication No. 2002/0170973) in view of Doi (U.S. Patent No. 5,995,712). The rejection is respectfully traversed.

As discussed during the personal interview, Applicants respectfully submit that the independent claims as amended require, *inter alia*, a selecting unit, which receives an operation to select at least one of the plural pieces of image data. The Office Action asserts that Teraura discloses, among other things, the claimed selecting unit because Teraura describes the control circuit 29 comprises a CPU, a ROM and a RAM. Applicants respectfully submit that Teraura fails to teach, suggest or otherwise render obvious, a control circuit 29 that receives an operation to select at least one of the plural pieces of image data, much less a selecting unit as presently claimed. Control circuit 29 of Teraura selects paper, not image data.

Accordingly, Teraura fails to teach or suggest, either alone or in combination with Doi, all of the currently claimed combination of features. Indeed, Doi fails to remedy the deficiency in Teraura. Specifically, Doi discloses sequential reading and therefore passive combination of two or more images to be formed on one recording paper sheet. In other words, there is no indication that there is an operation to select at least one of the plural pieces of image data using the selecting unit. As such, Doi fails to remedy the deficiency in Teraura. Withdrawal of the rejections based on Teraura of independent claims 1, 3, 16 and 17 as amended is respectfully requested.

With regard to independent claims 7, 9, 11 and 13 as amended, the Office Action asserts that Teraura teaches all of the currently claimed combination of features including "dividing an image read from the sheet of document paper." Applicants respectfully submit that Teraura fails to teach such a feature. The Office Action asserts, that the control circuit 29 of Teraura judges whether permission data is included in the data read from the RFID tag 14 in the sheet of document paper 61 in step B6. However, the copy operation shown in Fig. 7 varies depending on the judgment made in step B6. Teraura fails to teach or suggest dividing an image read from the sheet of document paper, and Doi fails to remedy this deficiency. Specifically, Doi discloses combining two separate images to a single output combined image, but fails to teach or suggest dividing a read image. Accordingly, Doi cannot remedy Teraura's failure to teach or suggest dividing an image read from the sheet of document paper.

Moreover, the Office Action asserts that the judgment unit is capable of executing the claimed dividing function. This inherency argument is unfounded. Merely because a certain structure is capable of providing or executing the claimed function does not make that function inherent in an apparatus having said structure. Indeed, the Patent Office must show that the judgment unit of Teraura necessarily executes the dividing an image function each and every time the judgment unit is employed. Without such a showing, the Office Action

cannot assert the judgment unit inherently accomplishes the claimed dividing function.

Accordingly, Teraura, either alone or in combination with Doi, fails to teach all the currently claimed combination of features of claims 7, 9, 11 and 13 as amended, and the withdrawal of the rejections thereof is respectfully requested.

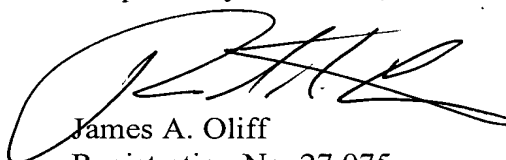
Claims 18-21 are added and are allowable for their dependencies in allowable base claims and for the additional features recited therein.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3, 5, 7, 9, 11, 13 and 16-23 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:RAC/lmf

Attachment:  
Petition for Extension of Time

Date: January 12, 2009

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